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AVON PRODUCTS, INC.			GHALI, ISIS A D	
AVON PLACE				
SUFFERN, NY 10901				
			ART UNIT	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PATENT.DEPARTMENT@AVON.COM

DETAILED ACTION

Examination of this application has been transferred from Examiner Sharmila Gollamudi Landau to Examiner Isis Ghali.

Receipt is acknowledged of applicants' amendment filed 09/05/2008.

Claim 13 has been canceled, and claims 25-28 have been added.

Claims 1-12 and 14-28 are pending.

Claims 1-12 have been previously withdrawn from consideration as being directed to a non-elected invention.

Election/Restrictions

1. Newly submitted claims 25-28 and claims 15-23 that have been amended to depend from claim 25 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: the newly added claim 25 and claims depend from claim 25 are directed to invention distinct from claim 24. The method of claim 24 is drawn to treating hair, while the method of claim 25 is drawn to deterring from the build up of sebum on the surface of the hair or scalp. Applicants state that new claim 25 is replacing claim

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13, which is canceled by the present amendment, in terms of deterring the build up of sebum on the surface of the hair. However, claim 13 was directed to method of treating hair, and recited silicone elastomer in an amount effective to deposit a sebum-absorbing level of elastomer on the hair or scalp. Deterring the build up of sebum reads on preventing or inhibiting the formation of sebum.

Claim 13 did not recite method of deterring the build up of sebum as applicants assert, contrarily, it included the functional language of the deposition of sebum absorbing level of silicone elastomer on hair or scalp. Sebum absorption of already formed sebum is different from prevention or inhibition of sebum build up. The method of claim 13 required sebum that had been already built up in order to absorb it, while the method of claim 25 does not require the presence of sebum, to the contrary prevents its build up.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 15-23, 25-28 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claims 1-12, 15-23 and 25-28 are withdrawn from consideration.

Claims 14 and 24 are included in the prosecution.

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The following rejections have been overcome by virtue of applicants' amendment and remarks:

- (A) The rejection of claims 13-24 under 35 U.S.C. 112, second paragraph, as being indefinite.
- (B) The rejection of claims 13-24 under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement.
- (C) The rejection of claims 13-16, 19-20, 22-24 under 35 U.S.C. 103(a) as being unpatentable over Ansher-Jackson et al (5,100,657) as evidenced by SISTERNA-SUCROSE ESTERS.

The following new grounds of rejections are necessitated by applicants' amendment and remarks:

Claim Rejections - 35 USC § 112

- 2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

- 3. Claim 14 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 14 as amended recites "polysiloxane-11". Recourse to the specification, no disclosure of "polysiloxane-11". In paragraph 0019 of published application,

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applicants disclosed “polysilicone-11”. Since this is trade name, it is not clear if both are the same or not. In accordance to MPEP 714.02, applicant should specifically point out to where in the disclosure a support for any amendment made to the claims can be found.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claim 14 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The expression “polysiloxane-11” does not set forth the metes and bounds of the claim. Recourse to the specification does not define the expression.

6. Claim 14 contains the trademark/trade name “polysiloxane-11”. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the

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trademark/trade name is used to identify/describe silicone elastomer and, accordingly, the identification/description is indefinite.

The following rejections have been discussed in details in the previous office action, and are maintained for reasons of record:

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

9. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary.

Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor

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and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

10. Claims 14 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bergmann et al (6,432,393) in view of Jakobson et al (5,466,719) or Jakobson et al (5,247,114).

Bergmann et al teach an aqueous hair composition in the form of shampoos, mousses, and conditioners which comprises elastomeric resinous material. See abstract. Bergmann teaches the elastomeric material preferably includes crosslinked silicone elastomers in an amount of 0.1-10%. See column 2, lines 45-60 and column 4, lines 45-20. The composition further comprises a mixture of surfactants in the amount of 0.1-50% including cationic, anionic, amphoteric, nonionic, and zwitterionic. See column 5, line 30 to column 6, line 15. See examples.

Bergmann does not teach the instantly claimed esters.

Jakobson (719) teaches polyglycerol fatty acid mixtures with an HLB of over 8 and preferably 10. The fatty acid component includes lauric acid. See examples. Jakobson teaches the polyglycerol fatty acid ester mixture can be used as a skin-care additive and/or detergent, cleaning agent or body shampoo, shower gel or shower composition, foam bath composition, liquid hand-cleaning agent or hair shampoo, since in addition to the surface-active property it also has

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a mild cleaning action as well as an oil-restoring effect and gives a pleasant feel to the skin during and after the cleaning process. See column 10, lines 44-52.

The polyglycerol fatty acid mixtures are used in the instant amount.

Jakobson (114) teaches a polyglycerine fatty acid ester mixture. Jakobson teaches a cleansing agent comprising as a surfactant a fatty acid polyglycerol esters containing C8-C24 fatty acid component (note lauric acid is C12). The mixture is used in the claimed amount. See examples. The cleansing agent which contains a surfactant comprising a fatty acid polyglycerol ester mixture and is suitable for use as a detergent, cleaning agent or an agent for cleansing the body, including the hair, for example, a shower gel or shower composition, foam bath composition, liquid hand-cleaning agent or hair shampoo. In addition to exhibiting a milder cleaning action than known cleansing agents, a cleansing agent containing a surfactant comprising a fatty acid polyglycerol ester mixture within the present invention also possesses certain additional properties, such as, for example, a refatting effect and the capacity to impart a pleasant feel to the skin during and after the cleansing process, and an improved flow in the surfactant mixture for the skincare additive. A further advantage of a cleansing agent containing as a surfactant a fatty acid polyglycerol ester mixture is that it is dermatologically and toxicologically harmless. See column 7, lines 1-16. The surfactant is used in combination with other conventional surfactants. See examples.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Bergmann et al and Jakobson et al ('719) and

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utilize the esters disclosed by Jakobson in the hair composition disclosed by Bergmann. One would have been motivated to add the esters to Bergmann's composition for the advantages taught by Jakobson including its mildness, oil-restoring effect to impart smoothness and softness. One would reasonably expected formulating composition for application to the hair, such as shampoo, comprising silicone elastomer and water soluble ester that has mildness, and oil-restoring effect to impart smoothness and softness to the hair.

Alternatively, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Bergmann et al and Jakobson et al ('114) and utilize the esters disclosed by Jakobson in the composition disclosed by Bergmann. One would have been motivated to add the esters to Bergmann's composition for the advantages taught by Jakobson including its mildness, refatting effect to impart smoothness and softness, and being dermatologically harmless. One would reasonably expected formulating dermatologically harmless composition for application to the hair, such as shampoo, comprising silicone elastomer and water soluble ester that has mildness, and refatting effect to impart smoothness and softness to the hair.

Regarding the HLB value, the examiner relies on Jakobson '719 as evidence to demonstrate that the polyglycerol fatty acid of Jakobson's '114 has an HLB above about 8.5.

Regarding the recitation "rinsing the hair to remove the composition", this is an implicit step when utilizing shampoos or conditioners (the prior art does not teach a leave-in-conditioner).

Response to Arguments

11. Applicant's arguments filed 09/05/2008 have been fully considered but they are not persuasive.

Firstly, applicants argue that tables 1-10 of their specification showed comparison between composition comprising combination of non-emulsifying silicone elastomer with water dispersible or water soluble esters and compositions lacking either one or both of the ingredients. The composition comprising both the elastomer and the ester showed superior and unexpected results in deterring the build up of sebum on the scalp and providing enhanced combing properties.

In response to this argument regarding unexpected results, it is argued that the objective evidence of nonobviousness must be commensurate in scope with claims that evidence is offered to support. See in Greenfield and DuPont 197 USPQ 227 (CCPA 1978); In re Boesch and Slaney 205 USPQ 215 (CCPA 1980); and In re Tiffin and Erdman 170 USPQ 88 (CCP 1971). The unexpected results obtained from very specific composition comprising one specific silicone elastomer and specific combination of esters, while the claims are broad regarding the ingredients. Further the unexpected result was better conditioning performance (paragraphs: 0055, 0059, and 0063). Additionally, the composition was tested and evaluated for wet detangling, wet feel after wet detangling, wet combing, wet fell after wet detangling, dry detangling and dry feel. Therefore, no showing of unexpected results regarding deterring sebum from build up as

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applicants assert. The unexpected result was improved conditioning performance.

Secondly, applicants argue that Bergmann teaches elastomer that can be silicone or non-silicone, and does not teach the esters. Jakobson's patents do not teach the silicone elastomer, and related to bath additives and skin cleansing agents. Both references do not teach method for deterring sebum build up on the surface of the scalp or hair.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Bergmann teaches the silicone elastomer for hair composition used for shampooing and conditioning the hair and further teaches silicone elastomer as preferred elastomer. Shampooing and conditioning read on method for treating hair instantly claimed by claim 24. The "comprising" language of the present claims does not exclude the presence of other ingredients such as non-silicone elastomer, active or inactive, even in major amounts. Jakobson teaches the claimed ester in cleansing composition and teaches shampoo in col.10, line 48 and col.11, line 17. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., method for deterring sebum build up on the surface of the scalp or hair) are not recited in the rejected claim(s).

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Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). The present claim 24 is directed to method of treating hair. In any event, the composition produced from combination of the reference is expected to perform the alleged function since compounds and their properties are inseparable.

Lastly, applicants argue that there is no reasonable basis for combining the teachings of Bergmann with the teachings of either or both Jakobson patents in a manner which would suggest Applicants' claimed method.

In response to this argument, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, one having ordinary skill in the art would have been motivated to combine silicone elastomer disclosed by Bergmann et al with esters disclosed by Jakobson et al ('719) for the advantages taught by Jakobson including its mildness, oil-restoring effect to impart smoothness and softness. Alternatively, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the silicone elastomer of Bergmann et al with the esters of Jakobson et al ('114) for the

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advantages taught by Jakobson including its mildness, refatting effect to impart smoothness and softness, and dermatologically harmless.

It has been held that "When a patent simply arranges old elements with each performing the same function it had been known to perform and yields no more than one would expect from such an arrangement, the combination is obvious." *KSR Int 'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1740 (2007) (quoting *Sakraida v. AG Pro, Inc.*, 425 U.S. 273,282 (1976)). "When the question is whether a patent claiming the combination of elements of prior art is obvious," the relevant question is "whether the improvement is more than the predictable use of prior art elements according to their established functions." In addition, "To determine whether there was an apparent reason to combine the known elements in the way a patent claims, it will often be necessary to look to interrelated teachings of multiple patents; to the effects of demands known to the design community or present in the marketplace; and to the background knowledge possessed by a person having ordinary skill in the art. To facilitate review, this analysis should be made explicit. But it need not seek out precise teachings directed to the challenged claim's specific subject matter, for a court can consider the inferences and creative steps a person of ordinary skill in the art would employ". Pp. 11-14. *KSR INTERNATIONAL CO. v. TELEFLEXINC. ET AL.* (2007). The invention as a whole is taught by the combination of the references.

A conclusion of obviousness under 35 U.S.C. 103 (a) does not require absolute predictability, only a reasonable expectation of success; and references

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are evaluated by what they suggest to one versed in the art, rather than by their specific disclosure. *In re Bozek*, 163 USPQ 545 (CCPA 1969).

In the light of the foregoing discussion, the Examiner's ultimate legal conclusion is that the subject matter defined by the claims would have been *prima facie* obvious within the meaning of 35 U.S.C. 103 (a).

12. Claims 14 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP 0855178 (of record) in view of Jakobson et al (5,466,719).

EP '178 teaches a hair composition that is rinsed off (shampoo and hair conditioners) that comprises instant water-insoluble silicone elastomer powders. The composition imparts softness, smoothness, and keeps the hair oil-free. See abstract and page 1. The composition may comprise one or more surfactants including anionic, nonionic, ampholytic, and cationic in the amount of 5-30% with no restriction. See page 2, lines 20-35.

The reference does not teach the instant esters.

Jakobson teaches polyglycerol fatty acid mixtures with an HLB of over 8 and preferably 10. The fatty acid component includes lauric acid. See examples. Jakobson teaches the polyglycerol fatty acid ester mixture can be used as a skin-care additive and/or detergent, cleaning agent or body shampoo, shower gel or shower composition, foam bath composition, liquid hand-cleaning agent or hair shampoo, since in addition to the surface-active property it also has a mild cleaning action as well as an oil-restoring effect and gives a pleasant feel to the skin during and after the cleaning process. See column 10, lines 44-52. The

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polyglycerol fatty acid mixtures are used in the instant amount. The esters can be used with other conventional surfactants.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of EP '178 and Jakobson et al and further utilize the instant esters. One would have been motivated to add the esters to EP' composition for the advantages taught by Jakobson including its mildness, oil-restoring effect to impart smoothness and softness. One would reasonably expected formulating composition for application to the hair, such as shampoo, comprising silicone elastomer and water soluble ester that has mildness and oil-restoring effect to impart smoothness and softness to the hair.

Regarding the recitation "rinsing the hair to remove the composition", this is an implicit step when utilizing shampoos or conditioners (the prior art does not teach a leave-in-conditioner).

Response to Arguments

13. Applicant's arguments filed 09/05/2008 have been fully considered but they are not persuasive.

Applicants argue that EP '178 does not teach the claimed esters, and Jakobson is directed to skin cleansing composition. None of the references suggest a method for deterring the buildup of sebum on the surface of scalp hair.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642

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F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). EP '178 teaches hair composition that is rinsed off (shampoo and hair conditioners) that comprises water-insoluble silicone elastomer. Jakobson suggested esters in the shampoo, col.10, line 48 and col.11, line 17. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., method for deterring sebum build up on the surface of the scalp or hair) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). The present claim 24 is directed to method of treating hair. In any event, the composition produced from combination of the reference is expected to perform the alleged function since compounds and their properties are inseparable.

Applicants further argue that the combination of these disparate teachings does not collectively suggest Applicants' claimed invention in an obvious manner.

In response to this argument, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21

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USPQ2d 1941 (Fed. Cir. 1992). In this case, one having ordinary skill in the art would have been motivated to combine silicone elastomer disclosed by EP '178 with esters disclosed by Jakobson et al ('719) for the advantages taught by Jakobson including its mildness, oil-restoring effect to impart smoothness and softness.

It has been held that "When a patent simply arranges old elements with each performing the same function it had been known to perform and yields no more than one would expect from such an arrangement, the combination is obvious." *KSR Int 'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1740 (2007) (quoting *Sakraida v. AG Pro, Inc.*, 425 U.S. 273,282 (1976)). "When the question is whether a patent claiming the combination of elements of prior art is obvious," the relevant question is "whether the improvement is more than the predictable use of prior art elements according to their established functions." In addition, "To determine whether there was an apparent reason to combine the known elements in the way a patent claims, it will often be necessary to look to interrelated teachings of multiple patents; to the effects of demands known to the design community or present in the marketplace; and to the background knowledge possessed by a person having ordinary skill in the art. To facilitate review, this analysis should be made explicit. But it need not seek out precise teachings directed to the challenged claim's specific subject matter, for a court can consider the inferences and creative steps a person of ordinary skill in the art would employ". Pp. 11-14. *KSR INTERNATIONAL CO. v. TELEFLEXINC. ET AL.* (2007). The invention as a whole is taught by the combination of the references.

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A conclusion of obviousness under 35 U.S.C. 103 (a) does not require absolute predictability, only a reasonable expectation of success; and references are evaluated by what they suggest to one versed in the art, rather than by their specific disclosure. *In re Bozek*, 163 USPQ 545 (CCPA 1969).

In the light of the foregoing discussion, the Examiner's ultimate legal conclusion is that the subject matter defined by the claims would have been *prima facie* obvious within the meaning of 35 U.S.C. 103 (a).

Conclusion

14. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Isis A. Ghali whose telephone number is

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(571) 272-0595. The examiner can normally be reached on Monday-Thursday, 6:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sharmila Landau can be reached on (571) 272-0614. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Isis A Ghali/
Primary Examiner, Art Unit 1611

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